REMARKS

This document is filed in reply to the final office action dated May 5, 2006 ("Final Office Action") and the advisory action dated September 15, 2006 ("Advisory Action"), and is subsequent to a Notice of Appeal filed September 5, 2006. Claims 1-29 are pending. Claims 1-7, 17-19, and 29 are under examination.

Independent claim 1 covers a method of detecting a target body in a specimen. The method includes acquiring and recording a first image and a second image at a location in a specimen field that has been exposed to a first fluorophore and a second fluorophore. Applicants previously amended claim 1 to specify that the first and second images are acquired and recorded at two different magnifications, i.e., a low magnification and a high magnification, respectively.

In the Final Office Action, the Examiner alleged that the amendment introduced new matter. He then rejected claims 1-7, 17-19, and 29 under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement. See page 3, lines 7-16. In response, Applicants pointed out a passage in the specification at page 8, line 27 through page 9, line 7, which supports the amendment. More specifically, this passage teaches a detection method that includes

> "scanning [a] specimen field at a low magnification for first sources of photons at [a] first wavelength and for second sources of photons at [a] second wavelength;
>
> registering the location of each first source and each second source within the specimen field;
>
> acquiring and recording a first image of the specimen field at each location, the first image generated via an optical or electronic filter that substantially blocks photons of the second wavelength but is permissive for photons of the first wavelength;
>
> acquiring and recording a second image of the specimen field at each location at a high magnification, the second image generated via an optical or electronic filter that substantially blocks photons of the first wavelength but is permissive for photons of the second wavelength;" (emphases added)

In the response to the Final Office Action, Applicants also submitted that, in view of this teaching, one skilled in the art would recognize that (i) the three steps of "scanning," "registering the location of each first source and each second source," and "acquiring and recording a first

image" are conducted at the "low magnification," and (ii) the step of "acquiring and recording a second image" is conducted at the "high magnification."

In the Advisory Action, at page 2, lines 1-7, the Examiner countered that

> Applicant points to [the supporting passage] of specification as providing support for the amended claim language, [na]mely support for the step of acquiring and recording second image at LOW magnification (emphasis added). However, said section of specification, although addressing scanning specimen[] field at low magnification - which is another preceding method step - does not address acquiring and recording second image at low magnification as now claimed. Specification does not seem to be describing image acquisition at different magnifications; rather, it addresses using low magnification to register location of photon sources rather than for image acquisition.

Applicants disagree and would like to point out that claim 1 recites "acquiring and recording a first image ... at the low magnification" and "acquiring and recording a second image ... at a high magnification" (emphasis added). The claim does not recite "acquiring and recording second image at LOW magnification" (emphasis original) as asserted by the Examiner.

Judging from the Examiner comments on the supporting passage at issue, it appears that the Examiner misread claim 1 and, by "second image," he meant "first image." It also seems to be the Examiner position that claim 1 does not meet the written description requirement because the supporting passage does not literally recite "acquiring and recording a first image at a low magnification."

Applicants respectfully traverse. As mentioned above, the supporting passage teaches a detection method that includes three consecutive steps: (1) scanning a specimen field at a low magnification for first sources of photons at a first wavelength and for second sources of photons at a second wavelength; (2) registering the location of each first source and each second source within the specimen field; and (3) acquiring and recording a first image of the specimen field. It is well known in the art of fluorescent microcopy, these three steps are routinely conducted in sequence. It is conventional that, when describing the sequence, one skilled in the art specifies the magnification only at the beginning and does not repeat it unless a different magnification is used. Thus, a skilled artisan would recognize that the three steps described in the supporting

passage are conducted at the same magnification despite that the passage does not literally recite "acquiring and recording a first image at a low magnification." In this connection, Applicants note that

> What is conventional or well known to one of ordinary skill in the art need not be disclosed in detail. See Hybritech Inc. v. Monoclonal Antibodies, Inc., 802 F.2d at 1384, 231 USPQ at 94. If a skilled artisan would have understood the inventor to be in possession of the claimed invention at the time of filing, even if every nuance of the claims is not explicitly described in the specification, then the adequate description requirement is met. See, e.g., Vas-Cath, 935 F.2d at 1563, 19 USPQ2d at 1116; Martin v. Johnson, 454 F.2d 746, 751, 172 USPQ 391, 395 (CCPA 1972) (stating "the description need not be in ipsis verbis [i.e., "in the same words"] to be sufficient"). (see MPEP 2163.II.A.3)

Here, in view of the teaching from the specification, a skilled artisan would understand the Applicants to be in possession of the claimed invention, including the step of "acquiring and recording a first image at a low magnification." Thus, even if the magnification at which this step is conducted is not explicitly described in the specification, adequate description requirement is met. For the above reasons, Applicants submit that the Examiner's position is untenable.

To justify his position, the Examiner also asserted that "for one skilled in the art it would seem counterproductive to acquire images of two fluorophores at different, low and high, modifications." See the Advisory Action, page 2, lines 6-7.

Applicants disagree. The specification teaches advantages of acquiring images of two fluorophores at different, low and high, modifications. For example, images of a low magnification allow one to scan for a large number of positive events quickly; and images of a high magnification allow one to observer each positive event in detail. See, e.g., page 25, lines 15-18; page 26, lines 20-22; and page 29, lines 12-16 of the specification. In view of these advantages, Applicants submit that it is not counter-productive to acquire images of two fluorophores at different modifications, low and high. To the contrary, it is desirable.

In view of the above remarks, Applicants submit that claims 1-7, 17-19, and 29 are in condition for allowance, and such action is respectfully requested.

Enclosed is a Request for Continued Examination and a Petition for Four Month Extension of Time. The fees in the amount of $395 and $795 are being paid concurrently on the Electronic Filing System (EFS) by way of Deposit Account authorization. Please apply any other required fees to deposit account 06-1050, referencing the attorney docket number shown above.

Respectfully submitted,

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